



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/485,583 | 02/14/2000 | KOICHI ENDO | ENDO=12 | 5957 |

7590

11/05/2002

BROWDY AND NEIMARK
624 NINTH STREET NW
SUITE 300
WASHINGTON, DC 20001

EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 11/05/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/485,583

Applicant(s)

ENDO ET AL.

Examiner

Alysia Berman

Art Unit

1617

--Th MAILING DATE of this communication appears on th cover sheet with th correspondence address --

THE REPLY FILED 15 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 8-11 and 15-18.Claim(s) withdrawn from consideration: 12-14 and 19-21.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 13.
10. ☒ Other: See Continuation Sheet


SREENI PADMANABHAN
PRIMARY EXAMINER

11/2/02

Continuation of 5. does NOT place the application in condition for allowance because: it does not overcome the 35 U.S.C. 103(a) rejection. Applicant's argument that there is no motivation to combine the references has been addressed in the Final Office Action mailed May 14, 2002, paper no. 12. With respect to applicant's argument that Hukkanen et al. is non-analogous art, both Hukkanen et al. and Therapeutics are directed to the same art, pharmaceuticals, and are solving the same problem, bone mass maintenance. Applicant states that one of ordinary skill in the art would not reach a method for treating a bone resorption-associated disease by maintaining bone mass given the disclosure in Therapeutics that states that antiresorptive therapy cannot lead to substantial gain in bone mass taken with Hukkanen et al. and Moore et al. Maintaining bone mass and gaining bone mass are not equivalent. Therapeutics teaches that anti-resorptive therapies act to maintain bone mass by inhibiting bone resorption, which is precisely the result desired by applicant.

Continuation of 10. Other: The information disclosure statement filed August 6, 2002 has not been considered because the fee was not paid as required by 37 C.F.R. 1.97(d). See MPEP 609..

Alyssa B.

Sreeni Padmanabhan

SREENI PADMANABHAN
PRIMARY EXAMINER

11/2/02